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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/555,709	07/19/2000	ANDREAS FERENCZ	H2933/3578UA	9120
7590 10/16/2003			EXAMINER	
Rocco S. Barrese, Esq. Dilworth & Barrese, LLP 333 Earle Ovington Boulevard Uniondale, NY 11553			SHORT, PATRICIA A	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 10/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b>	Application No. 09/555,709	Applicant(s) FERENCZ ET AL.	
	Examiner Patricia A. Short	Art Unit 1712	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED                FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☒ Applicant's reply has overcome the following rejection(s): 48-50.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 48-50.

Claim(s) objected to: none.

Claim(s) rejected: 1 and 19-47.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_.

Art Unit: 1712

### ADVISORY ACTION

5. With respect to the rejection of claims 1, 23-37, 43 and 47 under 35 U.S.C. 112, first paragraph, applicant argues that where no express description of a generic invention is to be found in the specification mention of representative compounds may provide an implicit description upon which to base generic language, i.e. a description of species that in the aggregate amounts to a description of the genus. There is no description of representative compounds or species that provide an implicit description of an aromatic-containing polyester prepared from an aromatic alcohol and an aliphatic acid encompassed by the language aromatic-containing polyester.

With respect to the rejection of claims 1 and 19-47 under 35 U.S.C. 103(a) as being unpatentable over Miller, the claimed adhesive differs from the exemplified adhesives of the reference in that an aromatic-containing polyester having a molecular weight ( $M_n$ ) of at least 8000 is required. The motivation to add a polyester having a molecular weight of at least 8000 to the exemplified adhesives of the reference is the teaching that the adhesive can have a preferred molecular weight as high as 10,000 and that a combination of polyesters can be used. Therefore, it would have been obvious to add an aromatic-containing polyester having a molecular weight of at least 8000 to the exemplified adhesives of the references or to prepare the adhesives of the reference using two aromatic-containing polyesters, one having a molecular weight of slightly less than 8000 and one having a molecular weight of at least 8000, in order to obtain the higher molecular weight adhesives. References are not limited to their examples.

P. Short

October 9, 2003

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**PRIMARY EXAMINER**

